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In re Patent No. of Sondbo et al.	:	DECISION ON REQUEST
Patent No. 7,678,930	:	FOR RECONSIDERATION OF
Issue Date: March 16, 2010	:	PATENT TERM ADJUSTMENT
Application No. 10/520,897	:	and
Filed: July 25, 2005	:	NOTICE OF INTENT TO ISSUE
Attorney Docket No. 10260.0007	:	CERTIFICATE OF CORRECTION

This is a decision on the "REQUEST FOR VACATING DECISION ON REQUEST FOR RECALCULATION OF PATENT TERM ADJUSTMENT IN VIEW OF WYETH" filed June 21, 2010. Patentees request that the patent term adjustment indicated in the patent be corrected from nine hundred twelve (912) days to eight hundred fifty-five (855) days.

The petition to correct the patent term adjustment indicated on the above-identified patent to indicate that the term of the above-identified patent is extended or adjusted to eight hundred fifty-five (855) days is **granted**.

On March 16, 2010, the above-identified application matured into U.S. Patent No. 7,678,930. The Patent issued with a revised Patent Term Adjustment of 912 days. On May 17, 2010, patentees filed a "NOTICE OF POSSIBLE PTO ERROR IN THE DETERMINATION OF PATENT TERM ADJUSTMENT AND REQUEST FOR CLARIFICATION OF CALCULATION." The Office mailed a "DECISION ON REQUEST FOR RECALCULATION OF PATENT TERM ADJUSTMENT IN VIEW OF WYETH" on May 21, 2010 that dismissed applicants request for recalculation. However, patentees did not file a Request for Recalculation of Patent Term Adjustment in View of Wyeth. As such, the decision mailed May 21, 2010 was mailed in error and is vacated.

Patentees filed the present correspondence on June 21, 2010, once again requesting the Office address the May 17, 2010

correspondence for recalculation based on grounds other than Wyeth.

Based on patentees' calculations, the patent term adjustment should be 855 days. Patentees assert that the Office's calculation of patent term adjustment fails to consider that after a Request for Continued Examination (RCE) was filed on August 4, 2009, that applicants filed Information Disclosure Statements on August 18, 2009, August 21, 2009, and September 20, 2009.

The Office concurs with patentees. Specifically, a reduction of 57 days should have been entered based on 37 CFR 1.704(c)(8). After applicants filed a reply on August 4, 2009 to a final Office action, applicants submitted three supplemental replies or papers in the form of Information Disclosure Statement (IDSs) on August 18, 2009, August 21, 2009, and September 30, 2009. The record does not support a conclusion that the examiner expressly requested the filing of the IDSs. Further, a review of the IDSs reveals that applicants did not include a statement under 37 CFR 1.704(d).¹ Thus, applicants failed to engage in reasonable efforts to conclude prosecution of the application.

All pursuant to 37 CFR 1.704(c)(8): The first period of reduction is 14 days, counting the number of days beginning on the day after the date the initial reply was filed, August 5, 2009, and ending on the date that the first IDS at issue was filed, August 18, 2009. The second period of reduction is 3 days, counting the number of days beginning on the day after the date the first IDS at issue was filed, August 19, 2009, and ending on the date that the second IDS at issue was filed, August 21, 2009. The third period of reduction is 40 days, counting the number of days beginning on the day after the date the second IDS at issue was filed, August 22, 2009, and ending

¹ Pursuant to 37 CFR § 1.704(d):

A paper containing only an information disclosure statement in compliance with §§ 1.97 and 1.98 will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application under paragraphs (c)(6), (c)(8), (c)(9), or (c)(10) of this section if it is accompanied by a statement that each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart application and that this communication was not received by any individual designated in § 1.56(c) more than thirty days prior to the filing of the information disclosure statement. This thirty-day period is not extendable.

on the date that the third IDS at issue was filed, September 30, 2009. Accordingly, a total reduction of 57 (14 + 3 + 40) days will be entered.

In light thereof, the correct patent term adjustment is eight hundred fifty-five (855) days, which is the sum of 681 days of delay under 35 U.S.C. 154(b)(1)(A) and 570 days of delay under 35 U.S.C. 154(b)(1)(B), reduced by 208 days overlap, reduced by 188 days of Applicant delay.

The Office will charge the required \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application is being forwarded to the Certificates of Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by **eight hundred fifty-five (855)** days.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3230.



Shirene Willis Brantley
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

PATENT : 7,678,930 B2

DATED : March 16, 2010

DRAFT

INVENTOR(S) : Sondbo et al.

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 912 days

Delete the phrase "by 912 days" and insert – by 855 days--